

## **REMARKS**

### Administrative Overview

Claims 1–20 were the subject of an appeal initially filed with the Office on February 1, 2008, and subsequently refiled on May 15, 2008. In the Office Action mailed on July 28, 2008, prosecution was reopened and claims 1–20 were rejected as unpatentable over United States Patent Application Publication No. 2003/0004850 to Li (hereinafter “Li”), and claims 8–14, 19 and 20 were said to be directed to nonstatutory subject matter.

We respectfully request reconsideration of the claims in light of the arguments below. After the entry of this response, claims 1–20 will be pending in this application.

### Existence of Related Applications

The Examiner’s attention is directed to United States Patent Applications Nos. 09/664,226, 10/831,969, and 09/999,670, all assigned to the assignee of the instant application, for appropriate consideration.

### Claims 8–14, 19 and 20 Reach Statutory Subject Matter

The instant Office Action rejected claims 8–14, 19 and 20 under 35 U.S.C. § 101 as directed to non-statutory subject matter, specifically as directed to computer programs. In particular, the Office Action claims that, “Software modules are non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like” (emphasis added). Office Action at 3.

Pending claims 8–14, 19 and 20 are directed to statutory subject matter. They do not recite “software modules.” In fact, claim 8 explicitly recites, “A computer-readable medium having encoded thereon software ... , the software comprising instructions for...” (emphasis added). This element is also present in all of the claims that depend from independent claim 8, i.e., claims 9–14, 19 and 20.

As the requested element is already present in the pending claims, we respectfully request the withdrawal of this rejection.

### The Claims are Patentable over Li

Claims 1–20 were rejected under 35 U.S.C. § 102(e) as anticipated by Li. Applicants respectfully submit that the pending claims are patentable in light of Li.

As a threshold matter, Li is cited as prior art against the instant application under 35 U.S.C. § 102(e). 35 U.S.C. §103(c)(1) provides that prior art pursuant to 35 U.S.C. § 102(e) cannot be used in an obviousness rejection against a commonly-owned patent application. At the time of the invention claimed in the instant patent application, both the Li reference and the instant patent application were subject to an obligation of assignment to the assignee of record, Emptoris, Inc. Accordingly, the Li reference cannot be prior art against the instant patent application for an obviousness rejection.

Moreover, as assignee is the owner of both the instant application and the Li reference, assignee is very familiar with the contents of the Li reference and, as demonstrated below, Li does not anticipate the pending claims. In particular, Li fails to teach, “determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount” (emphasis added).

A review of Li and the instant patent application reveals that the “Detailed Description” sections of both references are similar. Of note, Li includes additional discussion at paragraph [0179] et seq. and in the associated figures concerning the handling of rejected bids. Similarly of note, the instant application includes additional discussion at pp. 20–21 concerning business volume discounts and pp. 34–36 concerning optimization involving business volume discounts. Li does not include the material at pp. 20–21 and pp. 34–36 of the instant application concerning business volume discounts.

The instant Office Action cites the Abstract and paragraphs [0006], [0016], and [0064] of Li as satisfying the limitation at issue. In fact, none of the cited material discloses the determination of an optimal award schedule “utilizing the explicit offer of a business volume discount,” as required by each of the pending claims in the instant case.

Nothing in the Abstract mentions business volume discounts. Paragraph [0006] discusses the definition of an optimal award schedule, but again fails to mention business volume discounts. Paragraphs [0016] and [0064] discuss the computation of an optimal award schedule, but neither discusses the use of business volume discounts in that computation.

Accordingly, we respectfully submit that Li does not disclose or suggest the determination of an optimal award schedule “utilizing the explicit offer of a business volume

discount.” For this reason, independent claims 1 and 8 are patentable over Li, and the claims that depend therefrom are likewise patentable because they depend on a patentable base claim, and may also have additional patentable features.

**CONCLUSION**

In light of the foregoing, we respectfully submit that all of the pending claims are in condition for allowance. Accordingly, we respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of all of the pending claims in due course.

If the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting the allowance of this application, the Examiner is invited to call the undersigned at the number identified below.

Respectfully submitted,

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